

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APR Network, Inc.
A California corporation

Petitioner,

v.

JupiterMedia Corporation,
A Delaware corporation

Respondent

Cancellation No.: 92043766

Registration No.: 2514183
Date of Issue: December 4, 2001

75905816

Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

**PETITIONER APR NETWORK'S OPPOSITION TO
REGISTRANT JUPITERMEDIA'S MOTION TO SUSPEND/STAY
CANCELLATION PROCEEDINGS FILED BY PETITIONER APR
NETWORK**

**APR NETWORK'S POINTS AND AUTHORITIES IN
OPPOSITION TO JUPITERMEDIA'S MOTION**



12-07-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #72

I. STATEMENT IN OPPOSITION

Petitioner APR Network ("APR"), by and through its attorneys, Dana B. Robinson, Esq., and Steele N. Gillaspey, Esq., hereby opposes the Respondent's motion to suspend this Cancellation proceeding.

Faced with the threat of a lawsuit, APR filed, inter alia, a Declaratory Judgement action in the United States District Court for the Central District of California. Registrant JupiterMedia Corporation ("Jupiter") filed a counter claim seeking damages based upon trademark infringement. A Motion to Stay is now pending in said Court.

APR asserts that, inter alia, the Jupiter mark "search engine strategies" is violative of § 2, and that undisclosed facts establish that the mark is not viable under the controlling law, inclusive of being wholly descriptive.

APR asserts that there are issues in this cancellation proceeding that will bear upon the civil suit and will have great effect on the District Court proceeding. Resolution of the Cancellation will ensure that the court and parties to the civil action have a decision from this Board before proceeding with the civil action.

APR further asserts that this Board is the agency charged with the determination of registerability of marks, and that its review should properly take place as to all relevant issues of registration.

II. CASE FACTS

On or about January 28, 2000, Jupiter filed to register the mark Search Engine Strategies with the Trademark Office. The registration issued on or about December 4, 2004, in Int'l Class 41 (educational services). Jupiter sought and received registration for "conducting professional

seminars in the field of information technologies”. See, File History, U.S. Trademark Reg. No. 2,514,183.

In April 2004, APR purchased an internet domain name - “searchenginestrategies.biz” from a third party who had been continually using the name on the internet from not later than 2002. See Declaration of Robert Furman at ¶ 3 (“Furman Decl.”). APR uses the domain in its business of search engine optimization services; providing its clients with higher rankings on search engines. Furman Decl. at ¶ 4. APR actually performs work for clients to gain higher search engine rankings. Furman Decl. at ¶ 5.

Despite not taking any action regarding the some two years of active use of the domain name “searchengine strategies.biz,” in May 2004, Jupiter chose to attempt to use its registration to force APR to turn over its domain name to Jupiter. Furman Decl. at ¶ 6.

The Cancellation Proceedings before this Board and the civil litigation followed. A motion to stay pending the TTAB rulings in the cancellation proceeding has been filed. Furman Decl. Exhibit 1.

III. ARGUMENT

A. TTAB is the Proper Forum per Congress to Determine Registration of Trademarks

The Trademark Act of 1946, (commonly known as the Lanham Act) was enacted by Congress pursuant to *Article 1, § 8, clause 3*, of the United States Constitution. The Congress, through the Lanham Act (“the Act”), specifically empowered the U.S. Patent & Trademark Office to grant or deny registration of trademarks. 15 USC § 1501, et seq. The power conferred specifically includes the power to cancel. § 1064.

The threshold question of determining registrability on the Principal Register is exclusively within the jurisdiction of the Trademark Office, as governed by § 2 of the Act.

Refusal to grant registration may be determined by the Trademark Office on its own under § 2 of the Act, e.g.: sua sponte finding of a merely descriptive term under § 2(e); or by third party opposition during the registration process under § 13 of the Act; or by cancellation petition (after the opposition period) under § 14 of the Act. See also, 15 USC §§ 1052, 1063, 1064.

The Trademark Trial & Appeal Board (“TTAB”) is expressly empowered to “*determine and decide the respective rights of registration*” under § 17 of the Act. 15 USC § 1067.

Congress recognizes the special knowledge and abilities of the TTAB, as established by the powers conferred upon the TTAB by statute to determine and decide all issues regarding trademark registration, specifically including correcting an improper registration. Ibid.

B. The “Search Engine Strategies” Registration is Clearly Subject to § 17 Cancellation

The File History of this case establishes that the mark “search engine strategies” is, *inter alia*, not distinctive, not capable of acquiring secondary meaning, and that the mark is descriptive. The Trademark Office recognized such factors in its original denial of registration. As the file further reveals, Jupiter was disingenuous in its arguments for registration, failing to disclose key information and facts to the Trademark Office. Since the mark was not subjected to challenge by third parties, and since the Trademark Office was not apprised of the innumerable instances of same or similar use, APR submits that registration was granted through Jupiter’s failures to be complete in its arguments.

§ 17 of the Act, under the circumstances presented, is the appropriate method by which to determine the threshold question of registrability for only highly schooled and experienced employees of the USPTO are permitted to make the determination – “*employees of the Patent and Trademark Office...all of whom shall be competent in trademark law*” are the persons eligible for the three person panel making a case determination. One of the basis of APR

challenge now before the TTAB is under § 2 of the Act where registration is properly refused, or properly cancelled where:

*“a mark..when used on or in connection with the goods of the applicant
is merely descriptive.” § 2(e)(1), 15 USC § 1052.*

The same rules of prohibition apply to service marks - *“subject to the provisions relating to the registration of trademarks.”* § 3 of the Act, 15 USC § 1053, referencing § 2 of the Act.

APR has submitted to the TTAB its position that the term search engine strategies is wholly descriptive of the very goods/services Jupiter purports to provide. Miriam Webster’s on-line dictionary defines search engine as *“computer software used to search data (as text or a database) for specified information.”* Strategy(ies) is merely a plan or method. *Ibid.* Jupiter claims the term for conducting “seminars in the field of information technologies.” Information technologies, or “IT,” is the term for computer data use. Jupiter has not coined a distinctive mark, it has merely appropriated the actual definition of what is done – provide seminars to give strategies on how to plan to get higher rankings on search engines via use of the computer software used to search data. A cursory review of any internet search engine, such as “Google.com,” reveals hundreds of thousands of hits using the term “search engine” and/or “search engine strategies.”

No matter what theory is pled, it must be shown that the proffered mark is distinctive and capable of distinguishing the applicant’s goods and services from those of others. The Act is clear, and historically upheld, holding:

inherently distinctive..[marks].. are entitled to protection. In contrast, generic marks — those that ‘refer to the genus of which a particular product is a species — are not registrable as trademarks

Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected.

See, for example, § 2 of the Act as construed by, inter alia, Park N' Fly, Inc. vs. Dollar Park & Fly, Inc., 469 US 189, 194 (1985), citing to Abercrombie & Fitch Co. vs. Hunting World, Inc., 537 F.2d 4, 9 (1976).

C. Deference to the TTAB Recognized

Trial courts, specifically including the U.S. District Court for the Central District of California, historically defer to the expertise of the TTAB in issues relating to validity of asserted trademarks – “because of the efficiencies generated by the TTAB first addressing the issues involved.” Citicasters Co. v. Country Club Communities, 44 U.S.P.Q.2D 1223 (D. Cal., 1997). In Citicasters, the court granted a stay of proceedings, stating that it was confident that the TTAB will exercise its specialized knowledge in effecting a determination that will prove valuable to this court. *Id.*

If Jupiter's mark is cancelled, then the District Court will be better equipped to address the remaining claims. Contra, if this Board upholds the registration, then the District Court can move forward with confidence that its decision will not be later questioned based on a ruling of the TTAB.

D. Jupiter Argument Avoids Relevant Facts

In its Motion to Suspend Cancellation Proceeding, Jupiter cites cases where the Board granted motions to suspend pending a decision in civil court. None of the cases Jupiter cites had civil actions pending in the District Court for the Central District of California, where the parallel civil action in this case rests. The District Court for the Central District of California has shown a willingness in the past to await decisions by the TTAB when deciding its cases. See, Citicasters. The approach taken by the Central District is sensible, and puts the issues in proper order: first the registration should be addressed by the TTAB; and after a final decision of the

Board, the District Court can make a determination that relies upon the existence (or non-existence) of a federal trademark registration.

The Ninth Circuit has given the courts wide latitude to stay proceedings pending resolution of independent proceedings which bear upon the case. *Leyva v. Certified Grocers of Cal., Ltd.*, 593 F.2d 857, 863-64 (9th Cir.1979); see also, *Landis v. North American Co.*, 299 U.S. 248, 254 (U.S. 1936). Obviously, the Central District has utilized its broad power to stay proceedings in order to defer to the TTAB in similar circumstances.

Jupiter has argued in its Motion to Suspend Cancellation Proceeding that this Board **may** suspend a case where the civil action may have a bearing on the Board case. TBMP 510.02(a). Jupiter leads its legal argument with this premise. However, Jupiter has not made a case that anything the District Court will rule upon will have a bearing on this Board in its decision to cancel the registration. APR has **not** asked the District Court to cancel the registration based upon the fact that the mark is descriptive.

E. TTAB Determination Proper and Fair

APR believes that it is the TTAB that should rule on the issue of registrability; evaluate the descriptiveness of the mark; determine whether the mark has acquired secondary meaning; and evaluate whether Jupiter misrepresented material facts in its application. Jupiter claims that the District Court should evaluate these matters; and that if it issues an injunction to stop APR from using the domain name, APR will lose its standing to oppose the Jupiter Mark. This is simply wrong. APR will not lose standing to cancel the trademark registration if it is enjoined from using the domain name.

Further, Jupiter's argument underscores its true rationale in seeking the stay of TTAB proceedings – **Jupiter seeks to avoid expeditious TTAB consideration so as to unfairly seek to maintain the presumption of validity conferred by registration**. The Jupiter references to

injunctive relief establish such true intent. APR notes that injunctive relief under Federal Rules of Civil Procedure require a showing of a substantial likelihood of success on the merits at trial. It is equally clear that Jupiter desires to avoid or minimize that high standard of proof by relying upon the registration. APR contends that the registration for SEARCH ENGINE STRATEGES was issued due to unfair practices by Jupiter – further such practices should not be approved by the TTAB.

The TBMP states that if a civil proceeding is stayed, then the Board can proceed, “However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.” TMBP 510.02(a). APR has moved the District Court to stay the civil action pending the outcome of this cancellation proceeding. See Furman Decl. Exhibit 1. The grounds for the Motion to Stay the civil court action are founded in the published opinion of the same District. At a minimum, this Board should await a decision by the District Court as to the Motion to Stay before it determines to suspend the current proceeding.

The resolution of the issues before the TTAB will assist the District Court in its decision on the issues of declaratory relief and trademark infringement. APR believes that the resolution of this cancellation proceeding will bear heavily upon the various claims pending before the District Court. Therefore, this Board should deny the Respondent’s motion to suspend the cancellation proceeding.

The Trademark Trial & Appeal Board (“TTAB”) is expressly empowered to “*determine and decide the respective rights of registration*” under § 17 of the Act. 15 USC § 1067. The Petition is proceeding before the best tribunal, as recognized by both Congress and the Courts.

///

IV. CONCLUSION

As set forth in the Constitution, in the applicable U.S. Codes, and in the express intent of Congress and the Courts, the TTAB is the proper forum for this matter *"because of the efficiencies generated by the TTAB first addressing the issues involved."*

Jupiter properly faces the TTAB in this matter, and Jupiter's prior misleading acts in the registration process should not be rewarded with a presumption of validity in the Courts. Jupiter's motion should be denied.

DATED: December 7, 2004

DANA ROBINSON & ASSOC.

And

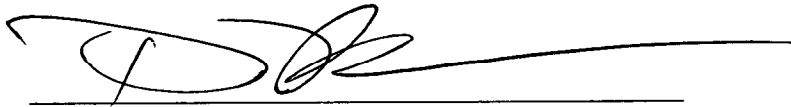
GILLASPEY & GILLASPEY

A handwritten signature in black ink, appearing to be 'D. Robinson', written over a horizontal line.

Dana B. Robinson
3803 Mission Blvd. Ste. 100
San Diego, CA 92109
Attorneys for Petitioner

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. ER 508559749 US, in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on December 7, 2004.

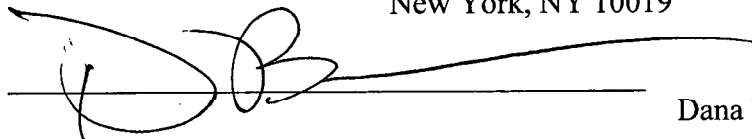


Dana B. Robinson, Esq.

Certificate of Service

I Dana Robinson hereby certify that on this 7 day, December 2004, I mailed by first class United States mail, postage prepaid, the foregoing PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND CANCELLATION PROCEEDING AND POINTS AND AUTHORITIES IN SUPPORT THEREOF to the following:

Lee Thayer
Willkie Farr & Gallagher, LLP
787 Seventh Ave.
New York, NY 10019



Dana B. Robinson, Esq.

Exhibit A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APR Network, Inc.)
A California corporation)
)
Petitioner,)
)
v.)
)
JupiterMedia Corporation,)
A Delaware corporation)
)
)
Respondent)
_____)

Cancellation No.: 92043766

Registration No.: 2514183
Date of Issue: December 4, 2001

Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

**DECLARATION OF ROBERT FURMAN IN SUPPORT OF PETITIONER APR
NETWORK'S OPPOSITION TO
REGISTRANT JUPITERMEDIA'S MOTION TO SUSPEND/STAY
CANCELLATION PROCEEDINGS FILED BY PETITIONER APR NETWORK**

I, Robert Furman, declare under penalty of perjury pursuant to the laws of the United States and the State of California that the following is true:

1. I have personal knowledge of the facts set forth below, except for those statements made on information and belief, and am competent to testify regarding these facts and statements. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

2. I am the President/CFO of APRNetwork, Inc. ("APR"), a company that is in the business of fee-for-service technical services in the field of search engine optimization.

3. In April 2004, APR purchased an internet domain name - "searchenginestrategies.biz" from a third party who had been continually using the name on the internet from not later than 2002.

4. APR uses the domain in its business of search engine optimization services; providing its clients with higher rankings on search engines.

5. APR actually performs work for clients to gain higher search engine rankings.

6. Despite not taking any action regarding the some two years of active use of the domain name "searchenginestrategies.biz," in May 2004, Jupiter chose to attempt to use its registration to force APR to turn over its domain name to Jupiter.

7. A motion to stay pending the TTAB rulings in the cancellation proceeding has been filed. A true and correct copy of the Motion to Stay is attached as Exhibit 1 and incorporated herein by this reference.

EXECUTED this 7th day of December 2004 at SAN FRANCISCO, California.

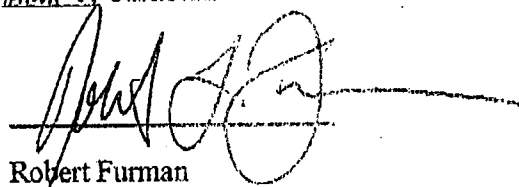

Robert Furman

Exhibit 1

1 Dana Robinson, Esq.
State Bar No. 208265
2 **ROBINSON & ASSOCIATES**
3803 Mission Boulevard, Suite 100
3 San Diego, California 92109
Telephone: 858.488.2545
4 - and -
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5 State Bar No. 145935
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6 225 Broadway, Suite 2220
San Diego, California 92101
7 Telephone: 619.234.3700
Attorneys for APR Network, Inc.

8 **IN THE UNITED STATES DISTRICT COURT**
9 **IN AND FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

10 APR NETWORK, INC., a
11 California corporation,
12 Plaintiff,

13 vs.

14 JUPITERMEDIA CORPORATION
a Delaware corporation,
15 Defendant

16 JUPITERMEDIA CORPORATION
17 a Delaware corporation,
18 Counterclaimant,

19 vs.

20 APR NETWORK, INC., a
21 California corporation,
22 Counterdefendant.

Case No. CV 04-7578 DSF [RNBx]

**APR NETWORK'S NOTICE OF MOTION
& MOTION TO STAY**

23
24 **Honorable Dale S. Fischer**
25 **U.S. District Court Judge, Judge Presiding**
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27

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1 TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

2 PLEASE TAKE NOTICE that Plaintiff APR NETWORK, INC., a California
3 Corporation, will move, and hereby does move for orders of this Honorable Court
4 granting a Motion to Stay to be heard on January 24, 2005 at 1:30 pm, or as soon
5 thereafter as the matter may be heard before Honorable Dale S. Fischer at the U. S.
6 District Courthouse, 312 North Spring Street, Los Angeles, CA 90012

7 This Motion is based upon this Notice of Motion and Motion to Stay, the
8 Memorandum of Points and Authorities in support of motion, the Declaration of Robert
9 L. Furman, the exhibit attached hereto, the documents and records on file herein, and
10 such other and further matter that the Court may deem just and proper.

11
12 DATED: December 7, 2004

13 DANA ROBINSON & ASSOCIATES
14 - and - GILLASPEY & GILLASPEY

15
16 By: 

17 Dana B. Robinson, Esq.,
18 -and- Steele N. Gillaspey, Esq.
19 Attorneys for Plaintiff/Moving Party,
20 APR NETWORK, INC.
21
22
23
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Attorneys for APR Network, Inc.

8 **IN THE UNITED STATES DISTRICT COURT**
9 **IN AND FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

10 APR NETWORK, INC., a)
11 California corporation,)
12 Plaintiff,)
13 vs.)
14 JUPITERMEDIA CORPORATION)
a Delaware corporation,)
15 Defendant)
16 JUPITERMEDIA CORPORATION)
17 a Delaware corporation,)
18 Counterclaimant,)
19 vs.)
20 APR NETWORK, INC., a)
California corporation,)
21 Counterdefendant.)
22

Case No. CV 04-7578 DSF [RNBx]

**APR NETWORK'S POINTS AND
AUTHORITIES IN SUPPORT OF ITS
MOTION TO STAY, PENDING
CANCELLATION PETITION BEFORE
TRADEMARK TRIAL AND APPEAL
BOARD**

23
24 **Honorable Dale S. Fischer**
U.S. District Court Judge, Judge Presiding
25
26
27

28 ///
APR v. Jupitermedia

APR MOTION STAY P&ACV04-7578

1 I. STATEMENT OF THE MOTION

2 A Petition for Cancellation by APR Network, Inc. ("APR") has been, and is
3 now pending, before the United States Patent & Trademark Office ("USPTO") before
4 the Trademark Trial & Appeal Board ("TTAB") concerning
5 Defendant/Counterclaimant Jupitermedia Corporation's ("Jupitermedia") asserted
6 trademark "search engine strategies".

7 The TTAB, as part of the USPTO, has been charged by Congress as the
8 primary arbiter of registerability of a mark, as determined by the Trademark rules and
9 regulations. The threshold issue in this case is the question of validity. The TTAB
10 is empowered to rule authoritatively on the issue of registrability, including, but not
11 limited to, descriptiveness. 15 USC §1064.

12 This case poses the very real possibility that this Court could find the mark not
13 generic, while the parallel TTAB action could concurrently find the mark invalid on
14 other grounds. This Court could uphold a mark on one ground, while the TTAB
15 cancelled the mark on other grounds not considered by this Court, thus rendering
16 moot the work of this Court.

17 A Motion to Expedite proceedings has been filed with the TTAB. For judicial
18 economy alone, and with proper deference to Congress's recognition of the TTAB's
19 specialized skill, a stay of this Court's proceedings is proper; pending the ruling of
20 the TTAB in the Cancellation Petition.

21 II. STATEMENT OF FACTS

22 Jupiter filed for a trademark on the subject term "search engine strategies"
23 seeking registration under Int'l Class 41, specifically for the purpose of "educational
24 services, namely conducting professional seminars". The filing date was January 28,
25 2000, with a first use in commerce date of November 18, 1999 (coincidentally the same
26 date as Jupiter's first use of any kind). Registration was granted by the USPTO on
27 December 4, 2001 - however, subject to an express disclaimer to the term "Search
28 Engine" set forth in the registration.

1 APR is in the business of internet placement for clients. See Declaration of
2 Robert Furman attached hereto as Exhibit A and incorporated herein by this
3 reference. The internet has exploded in recent years-it would seem that every
4 business and individual has a web site on the 'net. Large businesses such as Google
5 provide the gateway by which to access internet information through their search
6 engines. Id. at ¶ 4.

7 The key to any business with a web site is to come up on the search engine
8 result pages as high as possible, known as search engine optimization. Id. at ¶ 5.
9 APR provides the actual service of raising their client's position on the search engine
10 result pages. Id. at ¶ 6. APR itself comes up as one of the top five businesses on
11 almost all of the major search engine providers. Id. at ¶ 7.

12 APR purchased the internet domain name "searchenginestrategies.biz" from
13 Paul Viele of New York. Mr. Viele had utilized that mark/name from not later than
14 2002 for the purpose of providing educational information on search engine
15 strategies, and providing SEO services. Id. at ¶ 8. Although Jupiter admits actual
16 knowledge of Viele's use, Jupiter took no action as against Viele. Id. at ¶ 9. APR
17 purchased the domain name in April 2004. Id. at ¶ 10.

18 In May 2004, Jupiter contacted APR concerning the mark, threatening
19 infringement action. Id. at ¶ 11. APR reviewed matters, and confirmed that there
20 were literally hundred's of descriptive uses of the term "search engine strategies",
21 which uses well pre-dated the Jupiter first use date. Id. at ¶ 13. An extended period
22 of discussions took place between the parties. Jupiter continued its threats of
23 infringement. APR filed its Petition for Cancellation of the Jupiter mark, and also
24 filed this action.

25 In the Cancellation Proceedings now pending before the TTAB, APR has
26 asserted that the Jupiter registration is appropriately cancelled on grounds that, inter
27 alia, the mark is merely descriptive under Section 2(e)(1) of the Act (as originally
28 found by the USPTO), that innumerable instances of prior use exist, that innumerable

1 instances of required disclaimers of the terms "search engine" and "strategies" are of
2 record, and that Jupiter did not properly disclose such information in the original
3 proceedings. Jupiter has moved to oppose and stay the proceedings. APR
4 respectfully moves for stay of these proceedings in favor of pending TTAB
5 cancellation proceedings.

6 III. APR ARGUMENT IN FAVOR OF STAY

7 A. The Supreme Court and the Ninth Circuit Concur
8 That Granting of a Stay for the Completion of Dispositive
9 Administrative Proceedings Such as Present Here is Proper

10 APR urges this case should be stayed pending the outcome of the cancellation
11 proceedings before the TTAB. The TTAB has sole jurisdiction to determine all the
12 grounds set forth in the APR Cancellation Petition. See, Furman Decl. Exhibit 1.
13 Moreover, staying the proceedings would not cause undue harm to either party and
14 would also maintain efficiency in this Court's docket, because the resolution of the
15 trademark cancellation proceeding by the TTAB would be of valuable assistance to
16 this court in resolving the various claims arising in this suit. A ruling for cancellation
17 could be dispositive of the entire action.

18 The Supreme Court stated that *"the power to stay proceedings is incidental to*
19 *the power inherent in every court to control the disposition of the causes on its docket*
20 *with economy of time and effort for itself, for counsel, and for litigants"*. Landis v.
21 North American Co. 299 U.S. 248, 254 (U.S. 1936). Although a stay was denied in
22 Landis, the Court stated it would have upheld, were it not for the fact that the district
23 court had granted an unbounded stay.

24 No Unbounded Stay-Limited to Completion of Cancellation

25 The issues presented in this action, specifically the threshold issue of
26 validity are already before the TTAB on a requested expedited basis. In accord
27 with the Supreme Court, no unbounded stay is sought. As to the Landis Court
28 guidelines, a true "economy of time and effort" would be realized as the decision of
the TTAB would clearly be of assistance to this Court. In this case, a stay would

1 benefit the parties and counsel by allowing the central issue of validity to be
2 determined by the TTAB before litigating the issues set forth in the pleadings. The
3 TTAB members are the experts on this subject matter; and the subject matter of the
4 cancellation is under the sole purview of the TTAB. Further, the stay will benefit this
5 Court by enabling the Court to defer to the TTAB to determine the registrability of
6 the mark at issue. Once this issue is decided, this Court will be better equipped to
7 address any remaining issues, such as infringement and unfair competition.

8 Efficacy of Stay in Favor of TTAB Rulings

9 Although the current proceeding would be stayed awaiting the decision of an
10 administrative body, the Ninth Circuit has held that this is a valid reason to stay a
11 proceeding. The Ninth Circuit has held that:

12 *"[a] trial court may, with propriety, find it is efficient for its own docket*
13 *and the fairest course for the parties to enter a stay of an action before*
14 *it, pending resolution of independent proceedings which bear upon the*
15 *case. This rule applies whether the separate proceedings are judicial,*
16 *administrative, or arbitral in character, and does not require that the*
17 *issues in such proceedings are necessarily controlling of the action*
18 *before the court".*

19 Leyva v. Certified Grocers of California, Ltd., 593 F.2d 857, 863-864 (9th Cir. 1979).

20 The pending TTAB determination of the validity of Jupiter's trademark will
21 bear upon the suit before this Court. If the trademark is cancelled by the TTAB,
22 several of the claims before this Court will be rendered moot or the burdens of proof
23 will shift, and Jupiter's remedies will be circumscribed. Whatever the outcome of the
24 TTAB proceeding, the decision will have a significant impact on the present case,
25 including as to conservation of judicial time and resources, for all involved.

26 In Leyva, the Ninth Circuit found that it would be a waste of judicial resources
27 to have two substantially parallel cases proceeding at the same time. For example,
28 as in the Leyva case, the discovery that results from the TTAB action will be

1 substantially the same discovery that would be proffered in the present case. Thus,
2 not only will this Court benefit from the findings of the TTAB related to the validity
3 of the registration; but the parties will not be forced to produce duplicative discovery
4 in two parallel cases. Again, the spectre of two concurrent results - the potential of
5 this Court upholding the mark and the TTAB cancelling the registration (or vice -
6 versa) is the very rationale which the law has approved the issuance of a stay on a
7 Court proceeding in favor of administrative proceedings, such as TTAB
8 validity/cancellation proceedings.

9 B. This Honorable Court has Followed the Policy
10 of Favoring the Grant of Specific Stays in
Circumstances Such as Presented in this Action

11 In 1997, in the case of Citicasters Co. v. Country Club Communs., this
12 Honorable Court stayed a proceeding to await the resolution of a TTAB cancellation
13 proceeding "[b]ecause of the lack of demonstrable harm if a stay should be granted,
14 and because of the efficiencies generated by the TTAB first addressing the issues
15 involved." Citicasters, at 44 U.S.P.Q.2D 1223 (D. Cal., 1997).

16 No Demonstrable Harm by Grant

17 In the present case, APR has moved the TTAB to expedite the pending
18 cancellation proceeding in order to prevent an undue delay. Further, the facts of this
19 case underscore the lack of any viable claim of harm by Jupiter. Jupiter has
20 admittedly had actual knowledge of the <searchenginesstrategies.biz> domain name
21 since 2002. Jupiter, to APR's knowledge, took no action as to the then owner/user
22 Viele. There are no records presently known to APR showing that any court action
23 was brought as to such use of the claimed mark as to Viele. APR respectfully asserts
24 that under the present circumstances Jupiter cannot establish demonstrable harm if
25 a stay is granted, due to the elongated period of time the subject name search engine
26 strategies was used by another without apparent action by Jupiter.

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1 This Court's Stated Reliance on TTAB

2 This Court in Citicasters, in accord with Leyva, granted a stay to permit
3 completion of TTAB proceeding because, inter alia, of the Court's own finding that
4 there would "*be little in the way of new discovery, and the legal issue, though not*
5 *disposed of, will be clearly set out*". Ibid. Underscoring its reliance upon the efficacy
6 of the TTAB and the propriety of a stay, this Court stated:

7 *"the court is confident that the TTAB will exercise its specialized*
8 *knowledge in effecting a determination that will prove valuable to this*
9 *court"*

10 Id.

11 The request for stay made by APR is in harmony with the decision of the court
12 in Citicasters. The law and Court policy has repeatedly recognized the common
13 sense rationale favoring granting of a stay of court action to permit the TTAB to
14 decide the issue of registrability/validity – which is the threshold issue in this case.

15 The standards adopted by the Supreme Court, the Ninth Circuit, and this
16 Honorable Court are on point with the facts and circumstances presented by this case.
17 Applying those standards to this case support the granting of APR's requested stay
18 for the limited period pending the outcome of the expedited pending TTAB
19 proceeding.

20 IV. CONCLUSION

21 Based on the foregoing arguments, APR submits that this case should be stayed
22 for the limited period of time until there is a final outcome from the pending TTAB

23 ////

24 ////

25 ////

26 ////

27 ////

28 ////

1 proceedings on the issue of validity and registrability of the subject matter mark
2 which forms the material threshold issue between APR and Jupiter.

3
4 Respectfully submitted,

5
6 DATED: December 7, 2004

7 DANA ROBINSON & ASSOCIATES
8 - and - GILLASPEY & GILLASPEY

9
10 By: 

11 Dana B. Robinson, Esq.,
12 -and- Steele N. Gillaspey, Esq.
13 Attorneys for Plaintiff/Moving Party,
14 APR NETWORK, INC.
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1 I, the undersigned, do declare and state that I am employed in the county aforesaid; that I am
2 over the age of eighteen [18] years and not a party to the within entitled action; and that I am
3 executing this proof at the direction of a member of the bar of the above entitled Court. The business
address is:

4 ROBINSON LAW OFFICES
3803 Mission Boulevard, Suite 100
5 San Diego, California 92109

6 ☒ MAIL. I am readily familiar with the business' practice for collection and processing
7 of correspondence for mailing via the United States Postal Service and that the correspondence would
8 be deposited with the United States Postal Service for collections that same day in the ordinary
course of business.

9 ☐ FACSIMILE. I am readily familiar with the business' practice for collection and
10 processing of correspondence for electronic transmission and that the correspondence was
11 transmitted by facsimile that same day in the ordinary course of business, which transmission was
successful.

12 ☐ OVERNIGHT. I am readily familiar with the business' practice for collection and
13 processing of correspondence for overnight delivery/receipt next day via a major carrier such as UPS,
14 FED EX, DHL or similar carrier.

15 ☐ PERSONAL. The below described documents were personally served as set forth
below.

16 On the date indicated below, I served the within:

17
18
19 The above documents were served as set forth above and addressed as follows:

20 John C. Rawls, Esq.
Sarah Silbert, Esq.
21 FULBRIGHT & JAWORSKI
22 865 South Figueroa Street, 29th Flr
Los Angeles, California 90017

23 I declare under penalty of perjury, under the laws of the United States, that the foregoing is
24 true and correct and was **EXECUTED** on December 1, 2004 at San Diego, California.

25
26
27
28


1 Dana Robinson, Esq.
State Bar No. 208265
2 ROBINSON & ASSOCIATES
3803 Mission Boulevard, Suite 100
3 San Diego, California 92109
Telephone: 858.488.2545
4 - and -
5 Steele N. Gillaspey, Esq.
State Bar No. 145935
6 GILLASPEY & GILLASPEY
225 Broadway, Suite 2220
San Diego, California 92101
7 Telephone: 619.234.3700
Attorneys for APR Network, Inc.

8
9 **IN THE UNITED STATES DISTRICT COURT
IN AND FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

10 APR NETWORK, INC., a
11 California corporation,

12 Plaintiff,

13 vs.

14 JUPITERMEDIA CORPORATION
a Delaware corporation,

15 Defendant

16 JUPITERMEDIA CORPORATION
17 a Delaware corporation,

18 Counterclaimant,

19 vs.

20 APR NETWORK, INC., a
California corporation,

21 Counterdefendant.
22

Case No. CV 04-7578 DSF [RNBx]

**DECLARATION OF ROBERT L. FURMAN
IN SUPPORT OF PLAINTIFF APRNETWORK'S
MOTION TO STAY PENDING OUTCOME OF
CANCELLATION BEFORE TRADEMARK TRIAL
AND APPEAL BOARD**

23
24 Honorable Dale S. Fischer
U.S. District Court Judge, Judge Presiding
25
26
27

28 ///
APR v. Jupitermedia

APR MOTION STAY DECL-CV04-7578

1 I, Robert L. Furman, declare under penalty of perjury pursuant to the laws of the
2 United States and the State of California that the following is true:

3 1. I have personal knowledge of the facts set forth below, except for those
4 statements made on information and belief, and am competent to testify regarding
5 these facts and statements. I declare that all statements made herein of my own
6 knowledge are true and that all statements made on information and belief are
7 believed to be true.

8 2. I am the President/CFO of APRNetwork, Inc., a company that is in the
9 business of fee-for-service technical services in the field of search engine
10 optimization.

11 3. APR is in the business of internet placement for clients, a service known
12 as "search engine optimization" wherein APR uses its technological resources and
13 knowledge to increase the search engine ranking of its clients.

14 4. Large businesses such as Google provide the gateway by which to access
15 internet information through their search engines.

16 5. The key to any business with a web site is to come up on the search engine
17 result pages as high as possible, known as search engine optimization.

18 6. APR provides the actual service of raising their client's position on the
19 search engine result pages.

20 7. APR's website comes up as one of the top five business on several of the
21 major search engine providers. A company such as APR that offers SEO services
22 must have a website that is highly ranked in order to establish credibility with
23 potential consumers.

24 8. APR purchased the internet domain name "searchenginestrategies.biz" from
25 Paul Viele of New York. Mr. Viele had utilized that mark/name from not later than

26 ///

27 ///

28 ///

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VIPSES APR

1 - 15 - 04

1 2002 for the purpose of providing educational information on search engine strategies
2 and offering SEO services.

3 9. To my knowledge Jupiter not taken any action as against Vicks.

4 10. APR purchased the domain name in April 2004.

5 11. In May 2004, Jupiter contacted APR concerning the matter, threatening
6 infringement action.

7 12. It is my belief that Jupiter sought to obtain the .biz domain name from APR
8 because of the fact that APR had obtained high search engine ranking for the domain
9 name.

10 13. APR reviewed matters, and confirmed that there were literally hundreds of
11 descriptive uses of the term "search engine strategies", which uses well pre dated the
12 Jupiter first use date. An extended period of discussions took place between the parties.
13 Jupiter continued its threats of infringement.

14 14. APR filed its Petition for Cancellation of the Jupiter mark, and also filed this
15 action. A true and correct copy of the cancellation petition is attached hereto as Exhibit
16 1.

17 15. I believe that innumerable instances of prior use of the term "search engine
18 strategies" exist.

19 16. I believe that there are innumerable instances of registered trademarks that
20 disclaim the terms "search engine" and/or "strategies" are of record, and that Jupiter did
21 not properly disclose such information in the original proceedings.

22
23 EXECUTED this 15th day of December 2004 at Los Angeles, California.

24
25
26 Robert L. Farnham

27 APR v. Jupitermedia

28 - 3 -

APR MOTION STAY DEC 04 04/07/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APR Network, Inc.
A California corporation

Petitioner,

v.

JupiterMedia Corporation,
A Delaware corporation

Respondent

)
)
) Cancellation No.:
)
)
)

) Registration No.: 2514183
) Date of Issuc: December 4, 2001
)
)
)
)
)

PETITION FOR CANCELLATION

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

Dear Sir:

Petitioner, APR Network, Inc. ("APR"), a California corporation, having a place of business in Tarzana California, and a mailing address of 19360 Rinaldi St., #467, Porter Ranch, CA 91326, believes that it will be damaged by Registration No. 2514183 for the mark SEARCH ENGINE STRATEGIES in International Class 41 for educational services, namely conducting professional seminars in the field of information technologies, stating a date of first use as of November 11, 1999, and petitions to cancel same.

As grounds for cancellation, it is alleged that:

1. Petitioner has used the name as its domain name "searchenginestrategies.biz" and as part of a description of its services since February, 2004.
2. Petitioner acquired the domain name from a party that had used the domain name and the words "search engine strategies" since at least 2002 for information and services related to "search engine strategies," without objection by the Registrant.
3. Upon information and belief, the phrase "search engine strategies" is widely used as a description of services related to search engine optimization, i.e., search engine strategies; and said phrase has been used by third parties descriptively since prior to the date of application, and has been used by third parties in relation to seminars, which is the exact service offered by the Registrant.
4. Respondent applied to register SEARCHENGINE STRATEGIES, but was originally refused registration by the U.S. Patent and Trademark Office ("PTO") on the grounds that the mark was merely descriptive.
5. In response to examining attorney's July 17, 2000 Office Action refusing registration, Registrant argued that the mark was not merely descriptive, but suggestive. Registrant offered two alternate possible "meanings" for the mark, other than the meaning used by the Registrant. Registrant argued that because there are "several" possible definitions, the mark cannot be descriptive. The "several" meanings were essentially two meanings, at least one of which is descriptive.
6. Registrant failed to note that even if a mark may be suggestive or arbitrary as applied to some goods or services, that mark should be deemed descriptive if it is descriptive of any of the

goods or services for which registration is sought. *See 2 McCarthy on Trademarks*, § 11:51. *See also In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985) (Whether consumers could guess product [or service] from consideration of mark alone is not the test); *In re Home Builders Assn. of Greenville*, 18 USPQ 1313 (TTAB 1990) (question is whether someone who knows what the goods or services are will understand the mark to convey information about them).

7. Registrant argued that the mark was not descriptive because a consumer does not draw an immediate connection between SEARCH ENGINE STRATEGIES and either the educational services offered by Registrant, or the characteristic or quality of services of the Registrant's mark.

8. Registrant failed to note that the question of whether a MARK is merely descriptive must not be determined in the abstract, but in relation to the goods and services for which the registration was sought, the context in which the designation was being used, or in connection with said goods or services. *In re Morton-Norwich Products.*, 209 USPQ 791 (TTAB 1981).

9. A mark is merely descriptive if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute, or feature of the product or services in connection with which it is used, or intended to be used. *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978).

10. The goods that the Registrant offers are seminars that teach strategies for optimization of search engines. The relevant consumer, in this case domain name owners and other technology professionals, can readily understand the services that the mark describes.

11. In this case, the consumer does not need to use any imagination or additional thought

process to realize that SEARCH ENGINE STRATEGIES describes services related to strategies used for search engines. Therefore the mark is merely descriptive and not suggestive.

12. Registrant also responded to the Examiner's initial refusal by alleging that the mark was not descriptive, and citing a series of trademarks which were registered and included the terms "SEARCH ENGINE" or "STRATEGIES."

13. In its response, Registrant failed to cite the numerous trademark registrations that disclaimed the word "STRATEGIES" or the term "SEARCH ENGINE" apart from the mark as shown.

14. The examining attorney only allowed the mark to be published for opposition after receiving a thirteen page response from Registrant, and requiring a disclaimer of the words "search engine."

15. Registrant also argued that the rule of *In re Bel Paese Sales Co.*, and other cases should govern, where doubts regarding descriptiveness should be resolved in favor of the applicant. *In re Bel Paese Sales Co.*, 1 USPQ2d 1233 (TTAB 1986).

16. Registrant recognized in its response that its mark could be subject to challenge as descriptive by competitors who would be entitled to clarify whether or not the mark was descriptive. As such, the Examiner's ultimate decision to allow the application could have been predicated on the assumption that third parties with an interest in using the descriptive words SEARCH ENGINE STRATEGIES would challenge the application or registration on such grounds, and "resolved doubt" in favor of the applicant.

17. The Petitioner, having such an interest in the registration of the mark, is now

challenging the registration on those very grounds. Although previous doubt was resolved in favor of the applicant, now that evidence has been presented that the mark is descriptive, the registration should be cancelled.

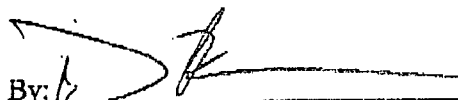
WHEREFORE, the Petitioner prays Registration No. 2514183 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

The filing fee of \$300 per class for one mark in once class is enclosed pursuant to CFR §2.111.

Respectfully submitted,

Dana B. Robinson

Dated: 9-15-2004

By: 
DANA B. ROBINSON, ESQ.
3803 Mission Blvd., STE 100
San Diego, CA 92019
858-488-2545
Attorney for Petitioner

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. ER 899453585 US, in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on September 15, 2004.


Dana B. Robinson, Esq.